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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,166	08/31/2000	Paul Chan H. Tse	NORT-0067 (12825RRUS01U)	2631
21906	7590	04/04/2006	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
09/652,166	TSE, PAUL CHAN H.	
Examiner	Art Unit	
Ovidio Escalante	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,6,8-16,19-21,25,26,28-33,35 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,8-16,19-21,25,26,28-33,35 and 37-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action is in response to applicant's amendment filed on January 17, 2006. **Claims 2,3,5,6,8-16,18-21,25,26,28-33,35,37-41** are now pending in the present application.
2. The Art Unit designation of this application has been changed to Art Unit 2614. Please make this change in any future response.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.
5. Claims 29, claims the non-statutory subject matter of a data signal embodied in a carrier wave. A claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 6, 19 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al. US Patent Pub. 2003/0061354 in view of Gleneck US Patent Pub. 2002/0041588.

***Regarding claims 6 and 19***, Burg teaches a method of making a call, (abstract; fig. 4A; paragraph 0058), comprising:

displaying a hyperlink, (paragraphs 0047 and 0056);  
receiving an indication of user selection of the hyperlink, (paragraph 0056);  
generating a call request based on the indication, (paragraphs 0058 and 0061);  
associating the hyperlink with a logical identifier of a remote party, (paragraphs 0061, 0063-0066).

Burg does not specifically teach of accessing rules information to determine further information to add to the logical identifier and providing charge information appended to the

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logical identifier for a toll call based on accessing the rules information, the charge information to be billed for the toll call.

In the same field of endeavor Gleneck teaches accessing rules information to determine further information to add to the logical identifier and providing charge information appended to the logical identifier for a toll call based on accessing the rules information, the charge information to be billed for the toll call, (paragraphs 0083,0091,0101-0103, the charge information represents toll calls such as long distance calls or international calls, i.e. adding the “1” prefix or international code before the number will make the call go to the toll carriers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by accessing rules information to further add information as taught by Gleneck so that the controller can properly added and prefixes to the telephone number if the number meets certain rules. For example for long distance numbers a prefix of 1 can be automatically added.

**Regarding claim 41**, Burg, as applied to claim 19, teaches wherein the generated call request comprises a Session Initiation Protocol call request, (paragraphs 0053,0100-0103).

9. Claims 8-11 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al. US Patent Pub. 2003/0061354 in view of Gunasekar US Patent Pub. 2005/0232173 and further in view of Donovan US Patent 6,453,034.

**Regarding claim 8**, Burg teaches a method of making a call, (abstract; fig. 4A; paragraph 0058), comprising:

displaying a hyperlink, (paragraph 0056);

receiving an indication of user selection of the hyperlink, (paragraph 0056); and

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generating a call request based on the indication, (paragraphs 0056-0058),  
wherein displaying the hyperlink comprises displaying a hyperlink associated with a  
uniform resource locator, (paragraphs 0056-0058).

Burg does not specifically teach adding calling card information to the call request to  
enable billing to the calling card information and a URL containing a telephone number.

In the same field of endeavor, Gunasekar teaches of adding calling card information to a  
call request to enable billing to the calling card information, (paragraphs 0022 and 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the  
invention was made to modify Burg by adding calling card information as taught by Gunasekar  
so that the service provider can properly make and bill the call properly.

Burg in view of Gunasekar do not specifically teach a URL containing a telephone  
number.

In the same field of endeavor, Donovan teaches that it was well known in the art to have  
a uniform resource locator which contains a telephone number, (col. 3, lines 45-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the  
invention was made to modify Burg and Gunasekar by having a URL contain a telephone  
number as taught by Donovan so that the user and system will known exactly who they are going  
to be connected to after the URL as been processed.

***Regarding claims 9-11***, Burg and Gunasekar, as applied to claims 8 and 22, does not  
specifically teach wherein displaying the hyperlink comprises displaying a hyperlink associated  
with a uniform resource locator having a protocol identifier and a string representing a logical  
identifier of a callee.

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In the same field of endeavor, Donovan teaches wherein displaying the hyperlink comprises displaying a hyperlink associated with a uniform resource locator having a protocol identifier and a string representing a logical identifier of a callee. (col. 3, lines 45-60). Donovan further teaches wherein the logical identifier comprises a telephone number and wherein the protocol identifier comprises a predetermined identifier to identify the uniform resource locator as a telephony-related uniform resource locator, (col. 3, lines 45-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by having a URL contain a telephone number as taught by Donovan so that the user and system will known exactly who they are going to be connected to after the URL as been processed.

***Regarding claim 40***, Burg, as applied to claim 8, teaches wherein generating the call request comprises generating a Session Initiation Protocol (SIP) call request, (paragraph 0053 and 0100-0104).

Burg in view of Gunasekar do not specifically teach the SIP call request containing the telephone number in the uniform resource locator.

In the same field of endeavor, Donovan teaches the SIP call request containing the telephone number in the uniform resource locator, (col. 3, lines 45-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg and Gunasekar by having a URL contain a telephone number as taught by Donovan so that the user and system will known exactly who they are going to be connected to after the URL as been processed.

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10. Claims 14-16,20,21,30,31,37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al. US Patent Pub. 2003/0061354 in view of Gunasekar US Patent Pub. 2005/0232173.

**Regarding claim 14**, Burg teaches a device capable of participating in call session over a data network, (abstract; paragraphs 0045 and 0058), comprising:

a display, (paragraphs 0047 and 0056);

a hyperlink presentable in the display and selectable by a user, (paragraphs 0051 and 0056); and

a controller to generate a Session Initiation Protocol (SIP) call request in response to selection of the hyperlink, the SIP call request for establishing a call session over the data network, wherein the hyperlink is associated with a uniform resource locator containing a logical identifier of a callee, the logical identifier being contained in the SIP call request, (paragraphs 0053, 0064-0067 and 0100-0104).

Burg does not specifically teach the controller adding calling card information to the call request.

In the same field of endeavor, Gunasekar teaches of adding calling card information to a call request to enable billing to the calling card information, (paragraphs 0022 and 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by adding calling card information as taught by Gunasekar so that the service provider can properly make and bill the call properly.

**Regarding claim 15**, Burg in view of Gunasekar, as applied to claim 14, teaches a storage device containing call rules, the controller to access the call rules to determine how the call



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request is to be generated, the call rules specifying that the calling card information is to be added, (paragraphs 0022 and 0023).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by adding calling card information as taught by Gunasekar so that the service provider can properly make and bill the call properly.

**Regarding claim 16**, Burg, as applied to claim 15, teaches the controller to determine if the call request is a local call or a toll call based on the call rules, (paragraphs 0008 and 0009).

**Regarding claim 20**, Burg, as applied to claim 14, teaches wherein the hyperlink is presentable in a browser screen in the display, (paragraphs 0047 and 0056).

**Regarding claim 21**, Burg, as applied to claim 14, teaches wherein the hyperlink is associated with a label that is presentable in the display and a uniform resource locator that is contained in the call request, (paragraphs 0056-0057).

**Regarding claim 30**, Burg teaches a device capable of participating in call sessions over a packet-based data network, (abstract; paragraphs 0048 and 0058; fig. 4A), comprising;

a display, (paragraphs 0051 and 0056);

a storage device to store hyperlinks associated with identifiers of callees, (paragraphs 0057; 0064-0066);

a controller (dialer agent), (paragraphs 0053, 0057-0061); and

a routine executable on the controller to present at least one of the hyperlinks on the display and to generate a Session Initiation Protocol (SIP) call request to establish a call session over the packet-based data network in response to selection of the at least one hyperlink, (paragraph 0053, 0100-0104).

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Burg does not specifically teach the routine adding calling card information to the call request.

In the same field of endeavor, Gunasekar teaches of adding calling card information to a call request to enable billing to the calling card information, (paragraphs 0022 and 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by adding calling card information as taught by Gunasekar so that the service provider can properly make and bill the call properly.

**Regarding claim 31**, Burg, as applied to claim 30, teaches telephone directory routine executable on the controller, the telephone directory routine to add the hyperlink to an address directory, (paragraph 0057).

**Regarding claim 37**, Burg, as applied to claim 30, teaches wherein the routine comprises a Session Initiation Protocol stack, (paragraphs 0053, 0100-0104).

**Regarding claim 38**, Burg, as applied to claim 30, teaches an Internet Protocol layer to communicate data in the call session, (paragraphs 0064-0067).

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al. US Patent Pub. 2003/0061354 in view of Gunasekar and further in view of Linden US Patent 6,360,254.

**Regarding claim 32**, Burg and Gunasekar, as applied to claim 30, does not specifically teach an electronic mail routine executable on the controller, the electronic mail routine to add the hyperlink to a message.

In the same field of endeavor, Linden teaches an electronic mail routine executable on the controller, the electronic mail routine to add the hyperlink to a message, (col. 7, lines 11-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by having electronic mail executable on the controller as taught by Linden so that the user can send the called party an e-mail message if the user is waiting in a queue and does not want to wait anymore.

12. Claims 2,3,5,12,13,25,26,28,33,35,39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al. US Patent Pub. 2003/0061354 in view of Vaziri US Patent Pub. 2004/00222235.

***Regarding claim 33***, Burg teaches a method of making a call, (abstract; paragraph 0058), comprising:

displaying, in a display of a terminal, a hyperlink, (paragraphs 0043 and 0056), wherein the hyperlink is associated with a logical identifier (paragraphs 0061,0063,0066);

receiving, by the terminal, an indication of user selection of the hyperlink, (paragraphs 0056-0057);

generating, by the terminal, a call request for establishing a call session over a packet-based network based on the indication, (paragraphs 0048, 0058 and 0061);

sending, by the terminal, the call request over the packet-based network, (paragraphs 0058-0063);

communicating, by the terminal, voice data over the packet-based network in the call session, wherein communicating the voice data over the packet-based network comprises communicating the voice data over an Internet Protocol network, (paragraphs 0048, 0058-0066).

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Burg does not specifically teach accessing rules information to determine information to add to the logical identifier, the further information to enable at least one of disabling call waiting, inserting a pause and navigating an automated call attendant.

In the same field of endeavor, Vaziri teaches accessing rules information to determine information to add to the logical identifier, the further information to enable at least one of disabling call waiting, inserting a pause and navigating an automated call attendant, (paragraph 0074).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by enabling the disabling of call waiting as taught by Vaziri so that users will not get disturbed during Internet calls.

**Regarding claim 2**, Burg, as applied to claim 33, teaches wherein displaying the hyperlink is performed in a browser screen, (paragraph 0056).

**Regarding claim 3**, Burg, as applied to claim 33, teaches associated the hyperlink with a telephone number of a remote party, (paragraphs 0047, 0056-0058).

**Regarding claim 5**, Burg, as applied to claim 33 teaches determining if the call session is local or long distance and adding prefix information if the call session is determined to be long distance, (paragraphs 0008 and 0009).

**Regarding claim 13**, Burg, as applied to claim 33, teaches wherein establishing the call session comprises establishing a call session with a remote terminal, (paragraphs 0056-0058).

**Regarding claim 35**, Burg teaches an article comprising one or more storage media containing instructions (abstract; paragraph 0058; fig. 4A) that when executed cause a device to: present a hyperlink in a display of the device, (paragraph 0056);

receive an indication of selection of the hyperlink, (paragraph 0056);  
receive a uniform resource locator associated with the hyperlink, (paragraphs 0063-0066); and  
generate a call request containing information in the uniform resource locator, the call request to establish a call session over a packet-based network wherein generating the call request comprises generating a Session Initiation Protocol message, (paragraphs 0053, 0100-0104).

Burg does not specifically teach the call request further containing one or more special characters to enable at least disabling call waiting.

In the same field of endeavor, Vaziri teaches the call request further containing one or more special characters to enable at least disabling call waiting, (paragraph 0074).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burg by enabling the disabling of call waiting as taught by Vaziri so that users will not get disturbed during Internet calls.

**Regarding claim 25**, Burg, as applied to claim 35, teaches wherein the instructions when executed cause the device to receive the uniform resource locator associated with a predetermined telephony protocol identifier, (paragraphs 0063-0066).

**Regarding claim 26**, Burg, as applied to claim 35, teaches wherein the instructions when executed cause the device to present the hyperlink in a browser screen, (paragraph 0056).

**Regarding claims 12 and 28**, Burg, as applied to claims 33 and 35, teaches copying the hyperlink from a first storage location accessible by a browser to a second storage location accessible by another application routine, (paragraph 0056-0058).

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*Regarding claim 39*, Burg, as applied to claim 33, teaches wherein sending the call request comprises sending, by the terminal, a Session Initiation Protocol call request over the packet-based network, (paragraphs 0053 and 00100-0104).

***Allowable Subject Matter***

13. Claim 18 is allowed.

***Response to Arguments***

14. Applicant's arguments with respect to claims **2,3,5,6,8-16,18-21,25,26,28-33,35,37-41** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any response to this action should be mailed to:

Commissioner for Patents

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P.O. Box 1450  
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Or:

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE**  
**PATENT EXAMINER**

*Ovidio Escalante*

Ovidio Escalante  
Primary Patent Examiner  
Group 2614  
March 31, 2006

O.E./oe